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09/770,462	01/29/2001	John A. Kriho	014530/0320	8030

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FOLEY AND LARDNER LLP
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EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 August 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>40-77</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>40-77</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail. Date _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed 8/5/05 to the
application filed on 1/29/01.

2.   Claims 40-77 are pending in the case. Claims 40, 50, 58, 59, 68 and 77 are
independent claims.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed
> publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4.   Claims 40-46, 49-54, 57-58 remain rejected under 35 U.S.C. 102(a) as being
anticipated by Kraft et al. (US pat No. 6,084,585, 7/4/00, filed 7/29/98, priority 12/5/97).

Regarding independent claim 40, Kraft discloses:

-     designing a template for a custom document that includes a changeable field,

       wherein the changeable field includes a name and further wherein designing the

       template comprises defining the changeable field (col 8, lines 1-20, 43-67, and

       col 9, lines 7-18: the template with the predefined menu for entering data values

       to the defined fields with the field name where the template has the features of

       adding extra fields to be associated with a single menu field in the template and

       enlarging the existing data field shows that the template is designed with the

       template fields which are defined changeable for a custom document)

- linking a plurality of data items to the changeable field (col 5, lines 37-43: data

    linked to the fields are pre-programmed for users to select; col 8, lines 43-58 and

    figure 6: a plurality of data linked to the field for user to select where the fields of

    the template are changeable (col 9, lines 7-18))

- creating a form wherein the form comprises the name of the changeable field

    paired with a list of the plurality of data items linked to the changeable field

    (figure 6 and col 8, lines 43-58: field name 312 paired with a list of data items in

    the pull-down menu 602 linked to said field where the fields of the template are

    changeable (col 9, lines 7-18))

- selecting a data item from the list (col 8, lines 43-58)

- populating the changeable field of the template with the selected data item

    thereby generating a document (figure 2 and col 8, lines 43-58, col 9, lines 7-18:

    selecting a data item to populate the changeable field of the template to generate

    the complete form)

Regarding claim 41, which is dependent on claim 40, Kraft discloses providing a

preview of the custom document by populating the changeable field of the template with

one of the plurality of data items linked to the changeable field (col 2, lines 22-39, col 9,

lines 7-18, col 10, lines 34-44: view the form prior submission).

Regarding claim 42, which is dependent on claim 41, Kraft discloses populating the

changeable field of the template with one of the plurality of data items comprises

defining a default selection to populate the changeable field (col 8, lines 43-58: the list

of pre-entered data entries is the plurality of data items defined as a default selection of

data to populate the changeable field).

Regarding claim 43, which is dependent on claim 41, Kraft discloses that populating the

changeable field of the template with one of the plurality of data items comprises

iteratively showing the preview with each data item in the list (col 2, lines 30-34).

Regarding claim 44, which is dependent on claim 40, Kraft discloses bundling the

plurality of data items with the template in a file (col 5, lines 37-43, col 8, lines 43-58).

Regarding claim 45, which is dependent on claim 44, Kraft discloses that the file has a

format of an application used to design the template (col 7, lines 50-67).

Regarding claim 46, which is dependent on claim 44, Kraft discloses sending the file to

a server, extracting the template and the plurality of data items from the file at the

server, and saving the extracted template and the extracted plurality of data items in a

database (figure 1, col 10, lines 1-22: sending the complete form to the server; col 10,

lines 15-25, 45-55, col 3, lines 5-31, figure 1: the data items and the template in the

complete form when submitted to the server will be stored in the storage 108-110, which

is a server database).

Regarding claim 49, which is dependent on claim 40, Kraft discloses automatically

adjusting a size of the selected data item based on a size of the changeable field (col 9,

lines 7-18: changing the size of a field by adding extra data fields to be associated with

a single menu field, the existing data field can be enlarged shows that the size of the

46field is adjusted).

Claims 50-54, 57 are for a computer program product of method claims 40-46, 49,

respectively, and are rejected under the same rationale.

Claim 58 is for a system of method claim 40, and is rejected under the same rationale.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 47 and 55 remain rejected under 35 U.S.C. 103(a) as being unpatentable

over Kraft as applied to claim 40 above, and further in view of Dunsmoir et al. (US Pat

No. 6,507,854 B1, 1/14/03, filed 11/5/99).

Regarding claim 47, which is dependent on claim 46, Kraft does not disclose modifying

the template using an application used to design the template, the application executing

at the server.

Dunsmoir discloses modifying the template using an application used to design the

template, the application executing at the server (col 5, lines 58-67: "providing a server-

side modifying web page template including format definitions, at least one of which

format definitions is a web page inclusion command").

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Dunsmoir into Kraft since Dunsmoir discloses modifying

the template at the server providing the advantage to incorporate into Kraft for desirably

changing the form structure in Kraft, which is a template, when said form is submitted to

the server.

Claim 55 is for a computer program product of method claim 47, and is rejected under

the same rationale.

8.   Claims 48 and 56 remain rejected under 35 U.S.C. 103(a) as being unpatentable

over Kraft as applied to claim 40 above, and further in view of Billiris et al. (US Pat

No.6,212,552 B1, 4/3/01, filed 1/15/98).

Regarding claim 48, which is dependent on claim 40, Kraft does not disclose creating a

mailing list, wherein the mailing list comprises a plurality of records to link to the

changeable field of the template, and successfully populating the changeable field of the

template with a record from the mailing list thereby generating a different document for

each record.

Billiris discloses creating a mailing list, wherein the mailing list comprises a plurality of

identities of message recipients (col 1, lines 40-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have modified Billiris and combined Billiris into Kraft for linking the mailing

list to the changeable field of the template and populating the changeable field of the

template with a record from the mailing list to generate a different document for each

record for the following reason. The mailing list including identities of message

recipients in Billiris is a list of records of recipients as the plurality of data in Kraft.

Replacing the plurality of data linking to the changeable field in Kraft with the plurality of

records of recipients in the mailing list linking to the changeable field and populating

such records to the changeable filed would provide different types of data to be used in

populating the fields in the form.

Claim 56 is for a computer program product of method claim 48, and is rejected under the same rationale.

9.   Claims 59-63, 65-72, 74-77 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (US Pat No. 6,084,585, 7/4/00, filed 7/29/98, priority 12/5/97) in view of Dunsmoir et al. (US Pat No. 6,507,854 B1, 1/14/03, filed 11/5/99).

Regarding independent claim 59, Kraft discloses:

- designing a template for a custom document using an application executing at a workstation, where designing the template comprises defining a changeable field (col 9, lines 7-18: the field within the template is *changeable* since _enlarging a field or adding extra data fields_ to a single menu field can be *made at a user's computer*; this shows that said template is designed with the fields of the template which are defined changeable for a custom document using an application executing at a workstation)

- linking a plurality of data items to the changeable field (col 5, lines 37-43: data linked to the fields are pre-programmed for users to select; col 8, lines 43-58 and figure 6: a plurality of data linked to the field for user to select)

- sending the template and the plurality of data items to a server (col 10, lines 15-22 and figure 1: the complete form including the template and the plurality of data items is sent to computer 102, which is a server)

Kraft does not disclose:

- editing the template using the application, the application executing at the server

Dunsmoir discloses:

- editing the template using the application, the application executing at the server
  (col 5, lines 58-67)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Dunsmoir into Kraft since Dunsmoir discloses modifying

the template at the server providing the advantage to incorporate into Kraft for desirably

changing the form structure in Kraft, which is a template, when said form is submitted to

the server.

Regarding claim 60, which is dependent on claim 59, Kraft discloses:

- creating a form wherein the form comprises the name of the changeable field

  paired with a list of the plurality of data items linked to the changeable field

  (figure 6 and col 8, lines 43-58, col 9, lines 7-18: field name 312 paired with a list

  of data items in the pull-down menu 602 linked to said field)

- selecting a data item from the plurality of data items linked to the changeable

  field (col 8, lines 43-58, col 9, lines 7-18)

- populating the changeable field of the template with the selected data item

  thereby generating the custom document (figure 2 and col 8, lines 43-58:

  selecting a data item to populate the changeable field of the template to generate

  the complete form)

Regarding claim 61, which is dependent on claim 60, Kraft discloses providing a

preview of the custom document by populating the changeable field of the template with

one of the plurality of data items linked to the changeable field (col 2, lines 22-39, col

10, lines 34-44: view the form prior submission).

Regarding claim 62, which is dependent on claim 61, Kraft discloses populating the

changeable field of the template with one of the plurality of data items comprises

defining a default selection to populate the changeable field (col 8, lines 43-58: the list

of pre-entered data entries is the plurality of data items defined as a default selection of

data to populate the changeable field).

Regarding claim 63, which is dependent on claim 61, Kraft discloses that populating the

changeable field of the template with one of the plurality of data items comprises

iteratively showing the preview with each data item in the list (col 2, lines 30-34).

Regarding claim 65, which is dependent on claim 60, Kraft discloses automatically

adjusting a size of the selected data item based on a size of the changeable field (col 9,

lines 7-18: changing the size of a field by adding extra data fields to be associated with

a single menu field, the existing data field can be enlarged shows that the size of the

46field is adjusted).

Regarding claim 66, which is dependent on claim 60, Kraft discloses bundling the

plurality of data items with the template in a file (col 5, lines 37-43, col 8, lines 43-58).

Regarding claim 67, which is dependent on claim 66, Kraft discloses sending the file to

a server, extracting the template and the plurality of data items from the file at the

server, and saving the extracted template and the extracted plurality of data items in a

database (figure 1, col 10, lines 1-22: sending the complete form to the server; col 10,

lines 15-25, 45-55, col 3, lines 5-31, figure 1: the data items and the template in the

complete form when submitted to the server will be stored in the storage 108-110, which

is a server database).

Claims 68-72, 74-76 are for a computer program product of method claims 59-63, 65-

67, respectively, and are rejected under the same rationale.

Claim 77 is for a system of method claim 59, and is rejected under the same rationale.

10.   Claims 64 and 73 remain rejected under 35 U.S.C. 103(a) as being unpatentable

over Kraft and Dunsmoir as applied in claim 60 above and further in view of Billiris et al

(US Pat No. 6,212,552 B1, 4/3/01, filed 1/15/98).

Regarding claim 64, which is dependent on claim 60, Kraft and Dunsmoir do not

disclose creating a mailing list, wherein the mailing list comprises a plurality of records

to link to the changeable field of the template, and successfully populating the changeable field of the template with a record from the mailing list thereby generating a different document for each record.

Billiris discloses creating a mailing list, wherein the mailing list comprises a plurality of identities of message recipients (col 1, lines 40-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Billiris and combined Billiris into Kraft and Dunsmoir for linking the mailing list to the changeable field of the template and populating the changeable field of the template with a record from the mailing list to generate a different document for each record for the following reason. The mailing list including identities of message recipients in Billiris is a list of records of recipients as the plurality of data in Kraft. Replacing the plurality of data linking to the changeable field in Kraft with the plurality of records of recipients in the mailing list linking to the changeable field and populating such records to the changeable filed would provide different types of data to be used in populating the fields in the form.

Claim 73 is for a computer program product of method claim 64, and is rejected under the same rationale.

Response to Arguments

11.   Applicant's arguments filed 8/5/05 have been fully considered but they are not persuasive.

Applicants argue that Kraft does not disclose "designing a template for a custom

document that includes a changeable field, ..." (Remarks, page 12).

Examiner respectfully disagrees.

Kraft discloses the argued feature. See the rejection above.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

13.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Farros et al. (US Pat No. 5,930,810, 7/27/99, filed 8/9/95).

Ho (US Pat No. 5,619,708, 4/8/97, filed 10/25/94).

Holt et al. (US Pat No. 5,557,723, 9/17/96).

Glasser et al. (US Pat No. 5,544,285, 8/6/96).

Barker et al. (US Pat No. 6,141,659, 10/31/00, 5/12/98).

Webber (US Pat No. 6,418,400 B1, 7/9/02, filed 12/30/98).

Silverbrook et al. (US Pat App Pub No. 2005/0041266 A1, 2/24/05, filed 9/20/04, priority 5/23/00).

Keys et al. (US Pat App Pub No. 2001/0050681 A1, 12/13/01, filed 3/30/01, priority 3/31/01).

Leone, III et al. (US Pat App Pub No. 2002/0065578 A1, 5/30/02, filed 11/29/00).

Resnick et al. (US Pat App Pub No. 2003/0009250 A1, 1/9/03, filed 6/24/02, priority 6/22/01).

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Examiner
Art Unit 2178
10/16/05